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United States Patent and Trademark Office
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DECISION ON PETITION UNDER 37 CFR 1.181

BACKGROUND

On 15 November 2007, the United States Designated/Elected Office (DO/EO/US)

mailed a Notification of Abandonment indicating that the application was abandoned for failure to respond to the Notification of Missing Requirements mailed 03 October 2005.

On 21 November 2007, applicant filed a "Petition under 37 CFR 1.181 to Withdraw the Holding of Abandonment." In decision dated 28 March 2008, applicant's petition to withdraw the holding of abandonment was dismissed without prejudice.

On 07 April 2008, applicant filed "Renewed Petition under 37 CFR 1.181 to Withdraw the Holding of Abandonment." In decision dated 13 May 2008, applicant's petition to withdraw the holding of abandonment was dismissed without prejudice.

On 09 July 2008, applicant filed (second) "Renewed Petition under 37 CFR 1.181 to Withdraw the Holding of Abandonment." The renewed petition requests withdrawal of the holding of abandonment, stating that a response to the Notification Of Missing Requirements was timely filed via facsimile on 28 October 2005.

DISCUSSION

As stated in the previous "Decision on Petition," the application file does not contain the materials purportedly filed by facsimile on 28 October 2005. In order to confirm the 28 October 2005 filing of the materials accompanying the present petition, applicants must satisfy the requirements set forth in 37 CFR 1.8.

37 CFR 1.8 sets forth:

(a) Except in the situations enumerated in paragraph (a)(2) of this section or as otherwise expressly excluded in this chapter, correspondence required to be filed in the U.S. Patent and Trademark Office within a set period of time will be considered as being timely filed if the procedure described in this section is followed. The actual date of receipt will be used for all other purposes.

(1) Correspondence will be considered as being timely filed if:

(i) The correspondence is mailed or transmitted prior to expiration of the set period of time by being:

(A) Addressed as set out in § 1.1(a) and deposited with the U.S. Postal Service with sufficient postage as first class mail;

(B) Transmitted by facsimile to the Patent and Trademark Office in accordance with § 1.6 (d); or

(C) Transmitted via the Office electronic filing system in accordance with § 1.6(a)(4); and

(ii) The correspondence includes a certificate for each piece of correspondence stating the date of deposit or transmission. The person signing the certificate should have reasonable basis to expect that the correspondence would be mailed or transmitted on or before the date indicated.

Petitioner argues that “the enclosed copy of the fax cover letter constitutes the required Certification of Transmission because (1) the fax cover letter states the date of transmission of October 28, 2005, and (2) is signed by Joseph R. Keating (attorney of record) who had reasonable basis to expect that the correspondence would be transmitted on or before the date of October 28, 2005.” However, petitioner’s assertion is incorrect. In this case, the fax cover sheet does not include a “certificate” as required under 37 CFR 1.8(a)(1)(A)(ii). A “certificate” is defined as “[a] written assurance, or official representation, that some event occurred, or some legal formality has been complied with.” (*Black’s Law Dictionary* 6th ed. (West Publishing, 1990)) No such assurance or official representation appears on the fax cover sheet. To the contrary, the record suggests that reliance was placed on the 37 CFR 1.8 certificate signed by Michelle Rhodes.

Petitioner has resubmitted the “Response To Notification Of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office” that references an attached declaration, contains a Credit Card Payment Form in the amount of the required surcharge but bears a “Certificate of Mailing” statement. The declaration of Michelle Rhodes states “[t]he response to Notification of Missing Requirements under 35 U.S.C. 371 in the Designated/Elected Office (DO/EO/US) inadvertently included a Certificate of Mailing, instead of a Certification of Transmission.” However, no new evidence to establish that the “Certificate of Transmission” statement as required by 37 CFR 1.8(a) was placed on the facsimile dated 28 October 2005 has been provided. Since, applicant did not comply with the provisions of 37 CFR 1.8(a), the petition under 37 CFR 1.8(b) cannot be granted. In summary, petitioners have not provided the proper showing necessary to withdraw the holding of abandonment.

Petitioner may wish to consider filing a petition under 37 CFR 1.137(b) to revive the instant application. Any petition filed under 37 CFR 1.137(b) must meet the criteria indicated in 37 CFR 1.137. This suggestion to consider filing a petition under 37 CFR 1.137(b) should not be construed as an indication as to whether any such petition will be favorably considered.

CONCLUSION

Applicant’s petition to withdraw the holding of abandonment is DISMISSED without prejudice.

If reconsideration of the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled “Renewed Petition under 37 CFR 1.181.” No additional fee is required.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-

1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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